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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/720,085	11/25/2003	Souichi Okada	1466.1080	4876

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EXAMINER

KIM, AHSHIK

ART UNIT PAPER NUMBER

2876

DATE MAILED: 09/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/720,085	Applicant(s) OKADA ET AL.	
	Examiner Ahshik Kim	Art Unit 2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 6/19/05 (Amendment).
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3 and 5-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3 and 5-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Amendment

1. Receipt is acknowledged of the amendment filed on June 19, 2005. In the amendment
5 claims 2 and 4 were canceled, and claims 1, 3, 5-9, 11, and 13-18 were amended. Currently,
claims 1, 3, and 5-18 remain for examination.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the
10 basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

- 15 3. Claims 1, 3, 5-7, 9, 12, 14, 17, and 18 are rejected under 35 U.S.C. 102(b) as being
anticipated by Deo et al. (US 5,721,781, hereinafter "Deo").

Re claims 1, 3, 7, 9, 12, 14, 17, and 18, Deo discloses a personal identification terminal
32 which checks person's identification by various means such as by smart card alone, or by
smart card and a personal identification number (PIN) and other additional security means (see
20 abstract; figure 9, col. 11, lines 1+). ATM machine can certainly interpreted as a server, and the
server checks identification and security level information when a transaction is initiated by the
user. Since security level is determined by the amount of transaction, the lowest level security
can be considered a default level. The smart card and the terminal transmit back and forth
various information which includes a digital signature (see abstract).

Art Unit: 2876

Re claims 5 and 6, when the smart card is authenticated by itself, it is inherent that the smart card and the card terminal communicate using a communication protocol. When PIN is additionally required, it is responding to different level of security requirement.

4. Claim 13 is rejected under 35 U.S.C. 102(b) as being anticipated by LeBourgeois (US 6,026,166, hereinafter "LeBourgeois").

See paragraph 7 for LeBourgeois' disclosure.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 8, 10, 11, 15, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Deo et al. (US 5,721,781) in view of LeBourgeois (US 6,026,166).

The teachings of Deo have been discussed above. However, Deo fails to specifically teach or fairly suggest that the personal identification terminal further comprises biometric information.

LeBourgeois discloses a smart card transaction system wherein the level of identity (or
5 authenticity) of the individual is verified depending on the transaction (see abstract; col. 2, lines 33+; col. 2, lines 56+; col. 4, lines 7-27; col. 9, lines 29-57). When a user is initially registered, a digital signature is provided (col. 5, lines 32+), and biometric information such as fingerprints or a retinal scan or photo ID is also collected (col. 6, lines 24+). In determining the identify, level of confidence is used by the financial institution. The level of confidence can be described as a
10 predetermined threshold to determine positive or negative authentication of the individual (col. 12, lines 3+; also see claim 2). The certification can have expiration time limiting the use of the certification.

In view of LeBourgeois' teaching, it would have been obvious to an ordinary skill in the art at the time the invention was made to further incorporate well-known biometric information
15 to the teachings of Deo in order to further reduce fraudulent use of the card and avoid the loss caused by identity theft. PIN provides a certain amount of security, however, PIN can be stolen by an observant individual or could be inadvertently given away the user. Accordingly, there have been numerous attempts to close this loophole and therefore protect the genuine users. For example, smart card comprising a fingerprint verification is well known and already used in the
20 industry. Therefore, incorporating biometric features to Deo would be well within one ordinary skill in the art.

Response to Arguments

8. Applicant's amended claims and arguments filed on June 19, 2005 have been fully considered, but they are not persuasive.

Examiner notes that Applicant amended claim 1 incorporating the subject matter recited in claims 2 and 4. However, in previous Office Action, claims 2 and 4 were anticipated by the Deo patent.

In responding to 35 USC 103 rejection, Applicant argues that LeBourgeois fails to disclose or suggest a structure of the claimed present invention. Examiner cited the LeBourgeois for biometric checking which Deo lacked, not for the structure of the terminal. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Moreover, the examiner respectfully submits to the Applicant that "It is not necessary that the reference actually suggest, expressly or in so many words, changes or possible improvements. All that is required is that the invention was made by applying knowledge clearly present in the prior art." *In re Scheckler*, 58 CCPA 936, 438 F. 2d 999, 168 USPQ 716 (1971).

The amended claims and remarks describing these elements have been fully considered, but they are not persuasive, and therefore, the Examiner has made this Office Action final. Examiner cited additional references, perhaps resembling the embodiment disclosed in the instant application.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

I. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Chou et al. (US 5,648,648); French (US 6,282,658); Rasmussen et al. (US 6,834,795) disclose systems checking different identification levels.

II. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ahshik Kim whose telephone number is (571)272-2393. The examiner can normally be reached between the hours of 6:00AM to 3:00PM Monday thru Friday. The fax number directly to the Examiner is (571)273-2393.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee, can be reached on (571)272-2398. The fax phone number for this Group is (703)872-9306.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [ahshik.kim@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.

Application/Control Number: 10/720,085

Page 7

Art Unit: 2876

A handwritten signature in black ink, appearing to read 'Ahshik Kim', with a stylized flourish at the end.

Ahshik Kim
Primary Examiner
Art Unit 2876
September 19, 2005